

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 29, 2008. At the time of the Office Action, Claims 1, 2 and 5-23 were pending in this Application. Claims 1, 2 and 5-23 were rejected. Claims 1, 14, 15, and 16 have been amended to further define various features of Applicant's invention. Claims 3-4 have been cancelled without prejudice or disclaimer. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 1, 2 and 5-23 were rejected by the Examiner under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicant amends Claims 1, 14, 15, and 16 to overcome these rejections and respectfully request full allowance of Claims 1, 14, 15, and 16 as amended.

Rejections under 35 U.S.C. §103

Claims 1, 2, 5 and 8-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,521,746 issued to Israel Elchonin Sand ("*Sand*") in view of U.S. Patent No. 6,651,099 issued to Russell S. Dietz et al. ("*Dietz*"). Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Applicant submits a new set of claims replacing, without prejudice, the current set of claims. The independent claims 1, 14, 15, and 16 now specify what is detected, namely the enumeration of packets (RTF speech packets) transmitted between the two VoIP endpoints in both directions. It is indeed this equilibrium condition that allows for no complicated and computationally intensive algorithms (as used in *Sand* and *Dietz*) to be required. Basis for this amendment can be found throughout the whole application as filed, especially, page 7, line 24 to page 8, line 7; and page 9, lines 4-11. Thus, no new matter has been added. A marked-up version of the new set of claims is enclosed, from which the Examiner may take the individual amendments made.

Turning to the rejection under 35 U.S.C. §103(a), the rejection is respectfully traversed because of the clarified amended set of claims filed. The present set of claims requires the enumeration (the counting of the number) of RTF speech packets transmitted between the two VoIP endpoints in both directions. Contrary hereto, *Sand* only discloses that a number (packet header information) is processed by an IP telephony measurement apparatus 32. In this respect, please see column 5, lines 24 to 34. It is noted that the cited passages by the Examiner, namely column 5, lines 55 to 62 and column 6, lines 21 to 22, are silent with respect to the counting the number of packet header information processed by the IP telephony measurement apparatus 32.

Sand fails to teach at least: the detection over a predetermined time period of the enumeration of RTF speech packets transmitted between the two VoIP endpoints in both directions; and the arithmetically processing of this enumeration.

Turning to *Dietz*, only packets within a specific flow may be counted. In this respect see column 20, lines 41 to 55 and especially column 20, line 44 where it is stated that only the counting of “packets associated with the flow” may be made. The flow is explained in column 10, lines 8 to 22, especially, lines 11 to 12, as the flow of packets associated with a

particular application. Hereby all packets belonging to one application may be accounted for to determine if all packets belonging to one application have been transmitted. This counting of packets within one application may be done for several applications and it is the statistics for these several applications that in *Dietz* may be used to determine the network's ability to transfer information. Consequently, *Dietz* fails to teach at least the detection **over a predetermined time period** of the enumeration of RTF speech packets transmitted between the two VoIP endpoints in both directions.

Furthermore, there is no motivation to combine *Sand* with *Dietz*. Applicant contends that *Dietz* would not be combined with *Sand*, because one of ordinary skill in the art would question the detailed processing mentioned as steps 1 to 11 in columns 5 and 6. The Examiner has suggested that one of ordinary skill in the art would combine *Sand* with *Dietz* to perform analysis and measures on the network usage and performance. Applicant contends that this motivation is not appropriate, since *Sand* already defines which steps need to be performed (collecting parameters ... computed being based on the sequence number, timestamp, length information; see column 6, lines 5 to 10). In other words there is no incentive for one of ordinary skill in the art to further modify the teachings of *Sand*. Therefore, a person skilled in the art would not modify *Sand* with *Dietz*.

Since both *Sand* and *Dietz* fail to teach the detection **over a predetermined time period** of the enumeration of RTF speech packets transmitted between the two VoIP endpoints in both directions, and there is no motivation to combine *Sand* with *Dietz*, it is respectfully requested that the rejection under 35 U.S.C. §103(a) is withdrawn. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

Association of Customer Number and Change of Correspondence Address

Applicant respectfully requests that all papers pertaining to the above-captioned patent application be associated with Customer No. **31625**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **31625**. All telephone calls should be directed to Andreas Grubert at 512.322.2545. A Revocation and Power of Attorney is filed herewith .

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicant

A handwritten signature in black ink, appearing to read 'A. Grubert', is written over the typed name and title.

Andreas Grubert
Registration No. 59,143

Date: August 28, 2008

SEND CORRESPONDENCE TO:
BAKER BOTTS L.L.P.
CUSTOMER ACCOUNT NO. **31625**
512.322.2545
512.322.8383 (fax)